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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER
BACKER, FIRMIN

ART UNIT	PAPER NUMBER
3621	

DATE MAILED: 10/27/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

	Application No.	Applicant(s)
Office Action Summary	09/692,746	BUSSELL, KEITH DAVID
	Examiner	Art Unit
	Firmin Backer	3621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>26 September 2003</u> .

2a)☒ This action is **FINAL**.   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-51* is/are pending in the application.

   4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-51* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

   Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

   If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

   a)☐ All b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____ .

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
         application from the International Bureau (PCT Rule 17.2(a)).

   * See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

   a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)	4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)	5) ☐ Notice of Informal Patent Application (PTO-152)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .	6) ☐ Other: .

Response to Amendment

This is in response to an amendment file on September 26th, 2003 for letter for patent

filed on October 18th, 2003 in which claims 1-51 were presented for examination. In the

amendment, claims 1, 2, 6-8, 12, 14 and 29 have been amended, claims 16-18 have been

canceled, and no claim has been added. Claims 1-15, 19-51 remain pending in the letter.

Claim Rejections - 35 USC § 103

1.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
> section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are
> such that the subject matter as a whole would have been obvious at the time the invention was made to a person
> having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the
> manner in which the invention was made.

2.   Claims 1-51 are rejected under 35 U.S.C. 103(a) as being unpatentable over Whitehouse

(U.S. Patent No 6,005,945 (*Applicant admitted prior art*) in view of Heiden (U.S. Patent No.

6,408,286).

3.   As per claim 1, Whitehouse teaches an on-line system for printing a value-bearing item

(VBI) (*electronic distribution of postage, 100)* comprising a plurality of user (*customer, 104)*

terminals coupled to a computer network (*network, fig 3)*, and a cryptographic device (*secure*

central computer 102, memory 154) remote from the plurality of user terminals and coupled to

the computer network *(see figs 3, 4, column 7 line 54-8 line 11)*, wherein the cryptographic

device includes a computer executable code for verifying that the advertisement graphics is

authorized to be printed next to the VBI (*see figs 3, 4, column 8 line 59-65, 9 line 12-50*).

Whitehouse fails to teach a digitally signed advertisement graphics to be printed next to the VBI.

However, Heiden teaches a digitally signed advertisement graphics to be printed next to the VBI

(*see abstract, figs 2, 3, column 5 lines 35-51*). Therefore, it would have been obvious to one of

skill in the art at the time the invention was made to modify Whitehouse's inventive concept to

include Heiden's a digitally signed advertisement graphics to be printed next to the VBI because

this would have allowed advertisers to take advantage of the space on the outgoing envelopes for

a particular postage meter user to advertise products and/or services thereby providing an

effective manner for advertisers to reach their target audience and providing economic incentive

for third parties advertisers postage meter users to participate.

4.   As per claim 2, Whitehouse teaches a system wherein the cryptographic device includes a

computer executable code for verifying the advertisement graphics using a DSA algorithm, a

public key, and a previously assigned digital signature (*see column 8 line 38-43, 9 line 51-63, 13

line 46-65*).

5.   As per claim 3, Whitehouse teaches a system wherein the computer executable code

verifies if the digitally signed advertisement graphics has a correct digital signature file (*see

column 8 line 38-43, 9 line 51-63, 13 line 46-65*).

6.   As per claims 4 and 5, Whitehouse teaches a system further comprising computer

executable code for tracking a usage of the VBI including one or more of number of users signed

up for the on-line system, number of users who have purchased at least a predetermined amount

of VBI, number of users who have printed at least a predetermined amount of VBI, and number,

of users who have maintained an account for a minimum number of predetermined period (*see*

column 4 line 59-5 line 2, 10 line 45-11 line 29).

7.   As per claim 6, Whitehouse teaches a system wherein the cryptographic module includes

a computer executable code for preventing unauthorized modification of data (*see column 15 line*

1-17).

8.   As per claim 7, Whitehouse teaches a system wherein the cryptographic module includes

a computer executable code for ensuring the proper operation of cryptographic security and VBI

related meter functions (*see column 5 line 3-17).*

9.   As per claim 8, Whitehouse teaches a system wherein the cryptographic module includes

a computer executable code for supporting multiple concurrent users (*see fig 3, 4, and 7).*

10.   As per claim 9, Whitehouse teaches a system further comprising a database remote from

the plurality of user terminals including information about the users (*see column 8 line 54-63).*

11.   As per claim 10, Whitehouse teaches a system further comprising a plurality of security

device transaction data stored in the database for ensuring authenticity of the one or more users,

wherein each security device transaction data can be processed in the server system in a stateless

manner (*see column 9 lines 32-63*).

12.   As per claim 11, Whitehouse teaches a system wherein each security device transaction

data is related to a user (*see column 9 line 12-31*).

13.   As per claim 12, Whitehouse teaches a system wherein the security device transaction

data related to a user is loaded into the cryptographic module wiper the user requests the operate

on a value bearing item (*see column 9 lines 32-63*).

14.   As per claim 13, Whitehouse teaches a system wherein the security device transaction

data related to a user is updated and returned to the database (*see column 9 lines 32-63*).

15.   As per claim 14, Whitehouse teaches a system wherein the cryptographic module

performs cryptographic function on a transaction related to the database (*see column 9 lines 32-

63*).

16.   As per claim 15, Whitehouse teaches a system further comprising computer executable

code for password authentication to prevent unauthorized access to the database (*see column 12

line 16-26, 57-64*).

17.   As per claim 19, Whitehouse teaches a system wherein the database includes one or more indicium data elements, data for account maintenance, and data for revenue protection (*see fig 1*).

18.   As per claims 20 and 21, Whitehouse teaches a system wherein the database includes virtual meter information, descending register data (*see column 13 line 20-45, 14 lines 25-36, 16 line 19-38*).

19.   As per claims 22-28, Whitehouse teaches a system wherein a bar code is printed on the value bearing item that is a mail piece with a digital signature, is a ticket, is a coupon, is currency, is a voucher (*see column 7 line 46-53, 8 line 14-18, 13 lines 56-60*).

20.   As per claim 29, Whitehouse teaches a method for printing an advertisement next to a value bearing item (VBI) (*electronic distribution of postage, 100*) via a communication network (*network, fig 3*) including a client system (*host system, fig 3*), and a server system (*secure central computer 102, memory 154*) (*see figs 3, 4, column 7 line 54-8 line 11*) comprising interfacing (*communicating*) with one or more users (*customer, 104*) via the client system (*host system, fig 3*), (*see figs 3, 4, column 7 line 54-8 line 11*) communicating with the client system over the communication network , and verifying the digitally signed advertisement graphics using a cryptographic module (*see abstract, and figs 3, 4 and 7*). Whitehouse fails to teach a digitally signed advertisement graphics to be printed next to the VBI. However, Heiden teaches a digitally signed advertisement graphics to be printed next to the VBI (*see abstract, figs 2, 3, column 5*

lines 35-51). Therefore, it would have been obvious to one of skill in the art at the time the

invention was made to modify Whitehouse's inventive concept to include Heiden's a digitally

signed advertisement graphics to be printed next to the VBI because this would have allowed

advertisers to take advantage of the space on the outgoing envelopes for a particular postage

meter user to advertise products and/or services thereby providing an effective manner for

advertisers to reach their target audience and providing economic incentive for third parties

advertisers postage meter users to participate.

21.   As per claim 30, Whitehouse teaches a method of verifying the advertisement graphics

using a DSA algorithm, a public key, and a previously assigned digital signature *(see column 9*

line 32-63, 16 line 19-67).

22.   As per claim 31, Whitehouse teaches a method verifying if the digitally signed

advertisement graphics has a correct digital signature file *(see column 9 line 32-63, 16 line 19-*

67).

23.   As per claim 32, 33, Whitehouse teaches a method further comprising tracking a usage of

the VBI including one or more of number of users signed up for the on-line system, number of

users who have purchased at least a predetermined amount of VBI, number of users who have

printed at least a predetermined amount of VBI, and number, of users who have maintained an

account for a minimum number of predetermined period *(see column 4 line 59-5 line 2, 10 line*

45-11 line 29).

24.   As per claim 34, Whitehouse teaches a method further comprising preventing

unauthorized modification of data (*see column 15 line 1-17*).

25.   As per claim 35, Whitehouse teaches a method further comprising ensuring the proper

operation of cryptographic security and VBI related meter functions (*see column 5 line 3-17*).

26.   As per claim 36, Whitehouse teaches a method further comprising supporting multiple

concurrent users (*see figs 3, 4 and 7*).

27.   As per claim 37, Whitehouse teaches a method further comprising including information

about the users in a database remote from the plurality of user terminals (*see figs 3, 4 and 7*).

28.   As per claim 38, Whitehouse teaches a method further comprising storing in the database

a plurality of security device transaction data for ensuring authenticity of the one or more users,

wherein each security device transaction data is processed in the server system in a stateless

manner (*see column 9 lines 32-63*).

29.   As per claim 39, Whitehouse teaches a method wherein each security device transaction

data is related to a user (*see column 9 line 12-31*).

30.   As per claim 40, Whitehouse teaches a method further comprising loading the security device transaction data related to a user into the cryptographic module when the user requests to operate on a value bearing item (*see column 5 line 3-17*).

31.   As per claim 41, Whitehouse teaches a method further comprising preventing unauthorized modification of data using the cryptographic module (*see column 15 line 1-17*).

32.   As per claim 42, Whitehouse teaches a method further comprising storing data for creating one or more indicium, account maintenance, and revenue protection (*see fig 1*).

33.   As per claim 43-46, Whitehouse teaches a method further comprising printing a mail piece includes a digital signature, a postage amount, an ascending register of used postage and descending register of available postage (*see column 13 lines 20-40, 14 line 25-36, 16 lines 19-38*).

34.   As per claim 47-51, Whitehouse teaches a method further comprising printing a ticket, printing a bar code, printing a coupon, currency, a voucher (*see column 7 line 46-53, 8 line 14-18, 13 lines 56-60*).

Response to Arguments

35.   Applicant's arguments filed September 26th, 2003 have been fully considered but they are

not persuasive.

　　a.   Applicant argues that the prior art taken alone or in combination fail to teach a

cryptographic module device that may be used for verifying the advertising graphics.

Examiner respectfully disagrees with applicant characterization of the prior art. Heiden

clearly teach an inventive concept wherein manufacturers may want to police the

redemption of their coupons to prevent fraudulent use of the digital coupons. For

example, by monitoring the unique coupon identification numbers, the vendor can

prevent duplicate use of the coupons. If the redemption is being done on line, the system

would detect the fraudulent use and prevent the coupon transaction from being

completed. Although the present invention is suitable for both on-line and off-line

redemption, the on-line redemption process is preferred. In the on-line redemption the

information, which is scanned from the coupon, is immediately transmitted to the vendor

data center, verified and accumulated before the transaction is completed. At the end of

the day, or at some prearranged interval, the vendor transmits the information to the

manufacturer or a representative of the manufacturer responsible for the coupon

advertising. When the *cryptographic process* is part of the on-line redemption, the vendor

data center operates as a trusted third party in performing the authentication. Once the

coupon is authenticated, the coupon can be discarded. Thus, the on-line redemption

eliminates the manual processing of the coupon because all the information from the

transaction has been accumulated and distributed. The retailer will be reimbursed for the

discount automatically from the transaction record. Preferably, the off-line redemption is

done as follows. The retailer receives the coupon locally, optionally authenticates the

coupon, provides the instant discount or rebate, and later transmits the information

scanned from the coupon to the vendor administering the third party advertising process

or directly to the manufacturer or a representative of the manufacturer responsible for the

coupon advertising. The authentication process may include a public key cryptographic

process whereby the scanned information includes all or part of a certificate or digital

signature of the information printed on the coupon. Alternatively, the retailer may send

the physical coupon to the manufacturer or manufacturer representative instead of or in

addition to transmitting the scanned information (*see column 11 lines 49-12 line 12*).

Conclusion

36.   **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time

policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within TWO

MONTHS of the mailing date of this final action and the advisory action is not mailed until after

the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,
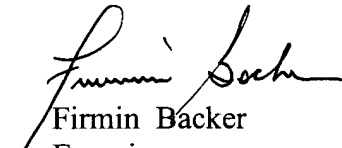
however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.
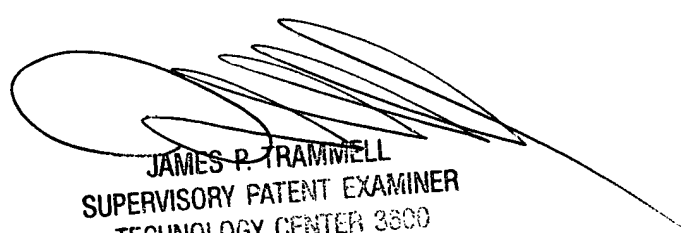
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Firmin Backer whose telephone number is (703) 305-0624. The examiner can normally be reached on Mon-Thu 8:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on (703) 305-9768. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-7687 for regular communications and (703) 305-7687 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

/Firmin Backer
Examiner
Art Unit 3621

October 22, 2003

JAMES P. TRAMMELL
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600